

REMARKS

I. STATUS OF CLAIMS

Claims 1 and 4-60 are pending in this case based on the amendments to the claims provided herein and claims 31-59 were withdrawn from consideration pursuant to a restriction requirement. No amendments are presented herein.

II. CLAIM OBJECTIONS

The Office objects to claims 4 and 5 under 37 C.F.R. § 1.75(c), as being of improper dependent form. Office Action at page 2. In particular, the Office contends that these claims recite R₁ as being C₁₋₄₀ hydrocarbon-based radicals in contrast to independent claim 1 in which R₁ is directed to C₈₋₄₀. *Id.* As provided in the Response filed on April 13, 2006, claims 4 and 5 were amended to replace the reference to “C₁₋₄₀” hydrocarbon-based radicals to “C₈₋₄₀” hydrocarbon based radicals on page 4 of the Response. Thus, claims 4 and 5 recite “C₈₋₄₀” hydrocarbon based radicals. As such, Applicants respectfully submit that further amendments to claims 4 and 5 are not necessary, and the objection to claims 4 and 5 is in error.

III. CLAIM REJECTION - 35 U.S.C. § 103

The Office rejects claims 1, 4-30, and 60 under 35 U.S.C. § 103(a) as unpatentable over WO 99/49837 to Philippe et al. (“Philippe”; the English translation of which is U.S. Patent No. 6,656,458). Office Action at page 3. According to the Office, “Philippe et al. teaches polyamino acid derivatives and their use in treating keratinous fibers.” *Id.* As noted by the Office, Philippe does not recite “the treatment of seborrhea of the skin and scalp, dermatological disorders associated with seborrhea and

dermatological disorders associated with *Propionibacterium acnes* and *Propionibacterium granulosum*.” *Id.* at pages 3 and 4. Although Philippe does not expressly teach such uses, the Office claims that Philippe would “inherently” treat the scalp for any disorders associated with the claimed disorders and thus, the present invention allegedly is obvious in view of Philippe. *Id.* at page 4. Applicants respectfully disagree and traverse the rejection for the following reasons.

The Office’s reliance on inherency to support an obviousness rejection is improper because unlike a Section 102 rejection, where each and every element must be found in a single prior art reference, the Office is attempting to use a combination of references to demonstrate the missing element for a Section 103 rejection. To support an assertion of inherency, however, the Office must prove factual and technical grounds establishing that the inherent feature *necessarily flows* from the teachings of the prior art. *See Ex parte Levy*, 17 U.S.P.Q. 2d 1461, 1464 (Bd. Pat. App. & Int. 1990). In the present case, the Office merely asserts that the prior art teaches the same components for a different use. This hardly counts as a factual and technical ground for establishing inherency.

For example, although Philippe teaches using polyamino acid derivatives for treating keratinous fibers, it fails to discuss using those compositions in the manner as presently claimed, i.e., directed to the skin, scalp, or dermatological disorders. In fact, Philippe’s teaching is directed to “the use of polyamino acid derivatives in a cosmetic composition *to strength and care for keratin fibers*, in particular the hair.” Philippe at Col. 1, ll. 7-9; *see also*, Philippe at Col. 3, ll. 60-63. It is unclear how one of ordinary skill in the art would use a teaching expressly directed to keratin fibers strengthening

and care to extend it to skin, scalp or dermatological orders without any guidance. Philippe simply provides no teachings or suggestions to do so. Moreover, Philippe discloses many uses that necessarily fall outside the scope of the treating skin, scalp or dermatological disorders, thereby disproving the Office's own theory that this use is necessarily present.

For at least these reasons, a *prima facie* case of obviousness is not established and thus, Applicants respectfully request the withdrawal of the rejection.

IV. CONCLUSION

In view of the foregoing Remarks, Applicants submit that this claimed invention, is not rendered obvious in view of the prior art reference cited against this application. Applicants, therefore, request the Office's reconsideration of the application, and the timely allowance of the pending claims.

If a telephone conference call would be useful in resolving any of these matters, the Examiner is urged to call Applicants' undersigned representative at 202.408.4345.

Please grant any extensions of time required to enter this response and charge any additional required fees to Deposit Account No. 06-0916.

Respectfully submitted,

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